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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/393,899	09/10/1999	MICHAEL F. BRAITBERG	4154-3	3485

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EXAMINER

CHARLES, DEBRA F

ART UNIT PAPER NUMBER

3628

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/393,899

Applicant(s)

BRAITBERG ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. Claims 31 and 36 have been amended. In light of the attorney's amendments, the claim objections for claims 36 and 37, and the 112, second paragraph objections have been withdrawn.

Response to Arguments

2. Applicant's arguments filed September 6, 2004 have been fully considered but they are not persuasive.

In response to the attorney's argument that CD-ROMS are read only, as per claim 31, the claim does not preclude writing the code onto the disk after receiving payment from the user, but prior to delivering the disk to the user. Therefore, the claimed optical disk could be a CD-ROM read-only disk. Additionally, throughout the past several decades electronic storage media have progressed from magnetic tapes to magnetic floppy disks (of various sizes) to optical CD-Rom disks to optical DVD read-only disks to optical DVD read-write disks. It would have been obvious to upgrade the reference's storage media from CD-ROM to the newer media of DVD (either read-only or read-write) in order to take advantage of the latest innovations in the electronic storage media.

In response to the attorney's argument that the references do not show payment tightly coupled to the optical disk distribution, the examiner has added in Evans et al. which

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does show purchase opportunity associated with the ID code and this incorporates payment for the purchase.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 31-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Subler et al. (U.S. PAT. 5646992A), Itami et al. (U.S. 6278984 B1) and Evans et al.(U.S.PUB. 2003/00126033 A1).

Re claims 31 and 34: Subler et al. disclose a method for distribution of content, comprising:

distributing information content-mastered optical disks to a plurality of users, wherein each optical disk includes the content and a unique identifier, and wherein a first portion of the content on each optical disk is readable by an optical disk reader only in response

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to the following steps(Abstract, Fig. 1, col. 3, lines 15-35, col. 9, line 35-col. 10, line 40, CD-ROM is an optical disk):

generating a access code by using the permission code and the unique identifier (Fig. 4, 5, 9, col. 9, line 35-col. 10, line 40, i.e. "unique request number" and "unique item encryption key", and col. 16, lines 20-30, i.e. "hybrid scheme"), and

wherein the optical disk reader(Fig. 1) may read the portion of the content stored on the optical disk; writing the access code onto the optical disk, whereby the optical disk reader may read the first portion of the content stored on the optical disk by using the access code or reading portion of the content using second access code(col. 3, lines 1-35, i.e. "controlling access of items to be distributed" and "arrange for users to have automatic access in later revisions to items that they paid for in earlier revisions" and the parallel of this is the distributor may charge a fee for subsequent access to items person paid for in earlier versions; and col. 4, line 15-40, i.e. "the valued items are stored on the CD-ROM in encrypted forma and are unusable by the end user until has paid for their use.")

Subler et al. disclose(s) the claimed invention except first or second access code, first or second permission code, first or second portion or distributing a first permission code to the optical disk reader in exchange for a first payment. However, in Abstract, Fig. 3, 4, col. 2, lines 39-col. 3, line 20, col. 4, line 35-57, col. 5, lines 50-67 thereof, Itami et al.

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disclose(s) first and second ID, comparing the first and second ID, reading the first and second ID. Thus, it would have been obvious to one of ordinary skill in the art to modify the method of Subler et al. by adopting the teachings of Itami et al. The motivation to combine these references is building the first and second checkpoints as signified by the ID is an effective way to ensure only content paid for is available to the purchaser.

Subler et al. and Itami et al. disclose(s) the claimed invention except distributing a first permission code to the optical disk reader in exchange for a first payment. However, in the Claim 7, page 29 thereof, Evans et al. disclose(s) an identifier code on a CD or DVD and payment effectively performed in para. 0041 when the opportunity to purchase is provided. It would be obvious to one of ordinary skill in the art to modify the invention of Subler et al. and Itami et al. based on the teachings of Evans et al. The motivation to combine these references is to effectively incorporate the payment functionality into Subler et al. and Itami as the code from the Evans et al.'s CD or DVD is transmitted to the media player.

Re claims 32, 36, 37, 39 and 40: Itami et al. and Evans et al. disclose(s) the claimed invention except distributing the first permission code comprises distributing the first permission code and first access code generated by a computer, which is remotely connected to the optical disk reader, via the internet. And the step of distributing information content-mastered optical disks comprises downloading the content to the

optical disks over a communications link. However, in col. 16, lines 30-45, Subler et al. disclose(s) computer network media which is an internet and a communications link. It would be obvious to one of ordinary skill in the art to modify the invention of Itami et al. and Evans et al. based on the teachings of Subler et al. The motivation to combine these references is to get the benefit of transmitting the content via the internet to speed transmission and keep distribution costs low.

Re claim 33: Subler et al. disclose the content includes content selected from among text content, music content, software and motion picture content(col. 3, lines 45-55, i.e. "not only for software, and databases, but for virtually any product").

Re claim 35: Subler et al. disclose the step of distributing information-content-mastered optical disks comprises unsolicited distributing of information content-mastered optical disks(col. 4, lines 15-35, col. 7, lines 44-55).

Re claim 38: Subler et al. disclose the first payment is a payment performed by authorizing a charge to a credit or debit account over a communications link(col. 15, lines 20-30, col. 16, line 10-40).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (703) 308-0505. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles
Examiner
Art Unit 3628


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